



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,613	05/14/2001	Peter G. Capek	YOR9-2001-0153US1 (728-20)	4824
28249	7590	08/11/2005	EXAMINER	
DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. UNIONDALE, NY 11553			FISCHETTI, JOSEPH A	
			ART UNIT	PAPER NUMBER

3627

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,613

Applicant(s)

CAPEK ET AL.

Examiner

Joseph A. Fischetti

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26,27,28,29,30,31,32-39,40-52,53,54,56-59 and 60-62 is/are pending in the application.
- 4a) Of the above claim(s) 28,31,40-52 and 56-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26,27,29,30,32-39,53,54 and 60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election without traverse of claims 35,54 in the reply filed on 5/20/05 is acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26, 27, 29, 30,32-39,53,54,60-62 are rejected under 35 U.S.C. 101 because there is no clear recitation of using a technological art, e.g. computerized system.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by De Lorme et al.

Delorme et al disclose a method in a computerized system of providing one or more personal use items for expected use by a user to one or more destinations to which the user intends to travel, the personal use items being provided by a plurality of suppliers able to deliver the personal use' items to the destination within a time frame set by the user. First. Inherent to any packing practice is determining by the user the personal use

Art Unit: 3627

items needed at the one or more destinations and to be packed in a suitcase (basic human packing technique); Delorme discloses describing in at least one data base (TRIPS) accessible via a network, each of the plurality of destinations to which the user can travel (col. 8 lines 37-48), each of the plurality of participating suppliers at each of said destinations (col. traveler shops for reservation among scuba providers), and personal use items offered by said suppliers at each of said destinations (see, col. 70 lines 28,29 special goods are read as "personal use items", e.g. scuba tank, regulator etc.); selecting a destination, personal use items, and a user's time frame (Temporal subsystem 860 allows selection of destination, "special goods e.g. personal items and time frame); generating at least one list of said selected personal use items picked from the plurality of items according to user's preferences, said user's time frame, availability of said personal use items, and ability of a supplier to deliver said personal use items to said destination within said user's time frame (see col. 70, lines 58-63 for list, ability is read as positive if the provider e.g. of scuba gear see col. 44 is offering to lease gear for hire); eliminating the personal use items contained on the at least one list from those items to be packed in the suitcase (read as inherent to any packing step); and said suppliers providing said personal use items to the destination within said user's time frame (scuba shop provides personal items tank regulator to person at time of arrival col. 44) .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 27, 29, 30, 32-39, 53, 54, 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Expedia.com in view of DeLorme et al.

First. Official notice is taken regarding the old and notorious practice of determining by the user the personal use items needed at the one or more destinations and to be packed in a suitcase (basic human packing technique). Expedia.com discloses providing one or more items (items are read as a bed to rest on, a bath to wash in etc,) for expected use by a user to one or more destinations (a) to which the user intends to travel the items being provided by a plurality of Suppliers (Hyatt, Sheraton Westin Hotels) able to deliver the items to the destination within a time frame set by the user (b). Expedia.com discloses describing in at least one database accessible via a network (www.expedia.com) each of the plurality of destinations (a) to which the user can travel, each of the plurality of participating suppliers at each of said destinations (c), and personal use items offered by said suppliers at each of said destinations (rooms are items offered by suppliers Westin, Hyatt etc. and see, col. 70 lines 28,29 "special

goods” are read as “personal use items”), selecting a destination, items, and a user's time frame (a,b,c): However, the Expedia .com web site does not disclose generating a result list . However official notice is taken with respect to the old and notorious use of consolidating results into a single document. Notwithstanding, DeLorme et al. disclose generating at least one list (col.70 lines 58-63) of said selected items picked from the plurality of items according to user's preferences said user's time frame, availability of said items, and ability of a supplier to deliver said items to said destination within said user's time frame. The step of eliminating the personal use items contained on the at least one list from those items to be packed in the suitcase is met with official notice of the old and notorious practice of not packing what you already have. The recitation of “said suppliers providing said items to the destination within said user's time frame” is not given any patentable weight because it is contingent upon a contractual obligation and not on methodology. Notwithstanding, Delorme does teach supplying same in col. 44. It would be obvious to modify the Expedia.com page to use a list as taught by Delorme et al and the use of the page to have advanced ordered at the destination personal use items, the motivation being to have a consolidated list of all items at one glance. Whether services or items are being accounted for is not deemed material given that a methodology is being claimed here.

RE claim 27. DeLorme et al disclosed a database of points of interest which is personalized to the individual and thus is capable of including destination previously visited or inquired on.

Art Unit: 3627

RE claim 29/30. DeLorme et al disclose using a scuba outfitter and given that this is a custom planning system clothing size, a height, and a weight would be used, including colors.

RE claim 32/33. DeLorme et al. disclose an Accounting Data substructure which determines a fee for providing said items.

RE claim 34. Hotels are rented.

RE claim 35. When TRIPS is prompted it generates a list or profile col. 70 lines 58-63)
claims 36-39: see restaurant reservation feature allowing reservation to be made down to minute in advance.

Re claims 53-55, TRIPS is an on-line system.

RE claim 62, 61 the use of a change of plans made in advance is deemed an old expedient in the art.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

Joseph A. Fischetti
Primary Examiner
Art Unit 3627


JOSEPH A. FISCHETTI
PRIMARY EXAMINER